

REMARKS

Specification

The Abstract is amended to delete "Fig. 1". Removal of the objection to the specification is respectfully requested.

Claim Rejections - 35 USC § 103

The rejection of claims 1-5, 7, and 9 under 35 USC 103(a) as being unpatentable over US 5964138 (Metzner et al.) in view of US 4221146 (Kindel et al.) is respectfully overcome by including the limitations of claim 6 (including the limitations of intervening claim 5) into independent parent claim 1. The limitations of claim 2 have also been incorporated into claim 1. Accordingly, claims 2, 5, and 6 are cancelled, along with claim 4.

All claims now include the limitations of original claim 6. Therefore, the patentability of the claims is argued below in connection with the rejection of claim 6.

Claim 6 is rejected under 35 USC 103(a) as being unpatentable over Metzner in view of Kindel in further view of US 6058824 (Neymeyr). Applicant respectfully traverses this rejection as it applies to claims 1, 3, and 7-9, which now all include the limitations of original claim 6, for the following reasons.

As correctly noted in the Office Action, Metzner discloses a pressure plate 6 for holding the microtome knife 2 in place. The pressure plate 6 of Metzner is clamped down against knife 2 by rotating eccentric rod 12. See column 2, lines 44-47. Metzner does not describe a trough or "boat" for holding water to receive the very thin section. Without the pressure plate, the knife 2 is loose and cannot be used to cut specimens.

Kindel et al. teaches a glass knife 2 of a type used in ultramicrotomy for cutting extremely thin sections. A trough or boat 1 is adhered directly to the knife to receive cut sections. The bottom 5 of trough 1 is not a pressure plate, but rather provides a surface for bonding the trough to the glass knife using sealing wax. See column 2, lines 17-20. There is no pressure plate in Kindel et al., as the glass knife may be used with or without trough 1. This type of trough or boat is mentioned by applicant in the Background of the Invention at paragraph [0008]. At paragraph [0009], applicant points out that that "[t]hese 'boats' cannot be used on metal microtome knives, however, since the metal microtome knives are clamped into knife holders by way of a pressure plate."

Accordingly, the prior art teaches two mutually exclusive arrangements: 1) a microtome knife clamped into a knife holder by a pressure plate, with no room for affixing a trough or boat to the knife; and 2) a microtome glass knife wherein a boat or trough is affixed directly to the knife by sealing wax, wherein no pressure plate is necessary.

Neither the primary reference Metzner nor the secondary reference Kindel et al. provides any suggestion whatsoever of how to incorporate a trough or boat in a microtome having a knife held in place by a pressure plate. The desirability of a trough for receiving thin sections after cutting is longstanding and without dispute, as evidenced by the 1980 patent to Kindel et al. However, there is no suggestion in the prior art of applicant's specific and elegant solution for microtome knives held by a pressure plate, which is to mount a U-shaped frame on the pressure plate, thereby using the pressure plate itself as a base of the trough. The combined prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Here, it is applicant's disclosure -- and only applicant's disclosure -- that teaches the limitations of amended claim 1.

Another indication that the invention defined by claim 1 is nonobvious relates to long felt need: despite the disclosure of a trough according to Kindel et al. back in 1980, it has taken more than 20 years for a solution usable with microtome knives held by a pressure plate as taught by applicant.

Regarding the limitation that a U-shaped frame (4) is mounted detachably on the pressure plate (3) by magnets (6), the Office Action relies on the disclosure of Neymeyr. However, this reference discloses a magnet 10 provided in a microtome knife holder for attracting a base of the knife to hold the knife in place while a clamping device is operated. The reference does not teach or suggest mounting anything to a pressure plate using magnets or other means.

For the foregoing reasons, favorable reconsideration of amended claim 1, and claims 3 and 7-9 depending therefrom, is respectfully requested.

Claim 8 is rejected under 35 USC 103(a) as being unpatentable over Metzner in view of Kindel in further view of US 2001/0003938 (Heid). Claim 8 depends from amended claim 1 and therefore is patentable for the reasons stated above concerning amended claim 1.

The Office Action identifies holding jaws 10 and plate 11 as being a pivotally mounted blade guard. Applicant respectfully notes that guard yoke 7, not jaws 10 and plate 11, is actually a pivotally mounted blade guard. See paragraph [0030] at the top of page 3. In this respect, the guard yoke 7 is pivotally mounted on pressure plate 4, and not on a U-shaped frame as claimed.

Thus, removal of the rejection of claim 8 is respectfully requested.

Appl. No. 10/811,601
Amendment and Response to Office Action
Reply to Office Action of Sept. 19, 2005

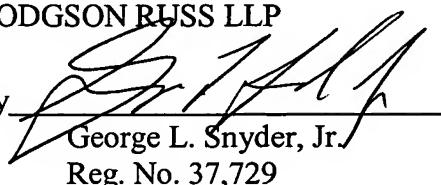
Conclusion

The present application is thought to be in a condition for allowance. If the Examiner has any questions, or the attorneys for applicant can assist in any way, the undersigned attorney may be contacted at the number provided below.

Respectfully submitted,

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By



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GLS/

Enclosures: Petition for One-Month Extension of Time (in duplicate)
Fee Transmittal
Check in the amount of \$120.00

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